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PATENT

Our Case No.: 10466/129
Genentech, Inc. Case No.: P2548P1C10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:)	
)	
Baker <i>et al.</i>)	
)	
Serial No.: 09/943,780)	Group Art Unit: 1643
)	
Filing Date: 8/30/2001)	Examiner: David J. Blanchard
)	
For: SECRETED AND)	Confirmation No.: 2570
TRANSMEMBRANE)	
POLYPEPTIDES AND)	
NUCLEIC ACIDS ENCODING)	
THE SAME)	

AMENDED APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On August 18, 2008 the Examiner made a final rejection to pending claims 27-29 and 32-34. A Notice of Appeal was filed on November 18, 2008.

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the Examiner. A request for a 1 month extension of time was filed February 18, 2009.

The following constitutes Appellant's Brief on Appeal, which has been corrected in response to the Notification of Non-Compliant Appeal Brief mailed March 12, 2009.

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I. REAL PARTY IN INTEREST

The real party in interest is Genentech, Inc.

II. RELATED APPEALS AND INTERFERENCES

The claims pending in the current application are directed to a polypeptide referred to herein as "PRO357." No other appeals or inferences involve claims directed to PRO357.¹ Appellants note however that the related application, U.S. Patent Application Serial No.09/945,584, filed August 31, 2001 (containing claims directed to PRO357 nucleic acids) issued as U.S. Patent No. 6,908,993 on June 21, 2005.

III. STATUS OF CLAIMS

Claims 1-26, 30-31, and 35-36 have been cancelled. All of the pending claims, claims 27-29 and 32-34, have been finally rejected and are appealed.

Claims 27-29 and 32-34 have been rejected under 35 U.S.C. § 101 as not being supported by a specific, substantial, and credible or by a well-established utility.

Claims 27-29 and 32-34 are rejected under 35 U.S.C. § 112, first paragraph as failing to satisfy the enablement requirement because allegedly one of ordinary skill in the art would not know how to use the claimed polypeptides.

¹ Appellants note that another application, U.S. Patent Application Serial No. 09/943,664 claims a different polypeptide, designated as "PRO347," but that like the claims here, the claims in that application rely on demonstrated gene amplification of the PRO347 nucleic acid to support an asserted diagnostic and therapeutic utility for the PRO347 polypeptide. The claims in U.S. Patent Application Serial No. 09/943,664 were finally rejected July 10, 2008, a notice of appeal was filed on November 10, 2008 and an appeal brief was filed February 10, 2009. A corrected appeal brief was filed April 9, 2009.

Claims 27-29 and 32-34 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by Botstein et al (WO 99/35170, published 7/15/99).

IV. STATUS OF AMENDMENTS

The last Amendment and Response in this case that was filed prior to the Notice of Appeal was filed on May 12, 2008, and has been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 27 is the only independent claim presented for review on appeal. Claim 27 is directed to a novel polypeptide identified in the application at issue here, U.S. Patent Application Serial No. 09/943,780, as the “PRO357 polypeptide” (specification pgs. 6, 13-14, 58, 106-107, 119-137). The PRO357 polypeptide of claim 27 is encoded by a nucleic acid that is amplified in lung and colon tumors, and functions as a therapeutic target and diagnostic marker for lung and colon cancer (specification pgs. 119-137).

Claim 27 specifies that the claimed polypeptide comprises the amino acid sequence of the polypeptide shown in Figure 26 (SEQ ID NO:69). The full-length PRO357 polypeptide having the amino acid sequence of SEQ ID NO:69 is described in the specification at, for example, Example 28, Figure 26 (described at page 21, lines 20-21 of the specification) and SEQ ID NO:69.

Claim 27 also specifies that the claimed polypeptide comprises the amino acid sequence of the polypeptide shown in Figure 26 (SEQ ID NO:69), lacking its associated signal peptide. A PRO polypeptide sequence lacking the signal peptide is described in the specification at, for example, pages 22-23.

Additionally, claim 27 specifies that the claimed polypeptide comprises the amino acid sequence of the polypeptide encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 209527. The cDNA nucleic acid encoding PRO357 is described in the specification at, for example, Example 28, Figure 25 (described at page 21, lines 18-19 of the specification) and SEQ ID NO:68.

All other pending claims, claims 28, 29, and 32-34 depend from independent claim 27 and stand or fall with independent claim 27. Claims 28 and 29 are directed to a polypeptide comprising the amino acid sequence of the polypeptide shown in Figure 26 (SEQ ID NO:69), either having (claim 28) or lacking (claim 29) the associated signal peptide. The polypeptide claimed by claim 28 is described in the specification at, for example, Example 28, Figure 26 (described at page 21, lines 20-21 of the specification) and SEQ ID NO:69. The polypeptide claimed by claim 29 is described in the specification at, for example, pages 22-23. Claim 32 is directed to a polypeptide comprising the amino acid sequence of the polypeptide encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 209527. The polypeptide claimed by claim 32 is described in the specification at, for example, Example 28, Figure 25 (described at page 21, lines 18-19 of the specification) and SEQ ID NO:68. Claim 33 is to a chimeric polypeptide comprising one of the above polypeptides fused to a heterologous polypeptide, which is described in the specification at page 53, lines 15-36. Claim 34 is to a chimeric polypeptide wherein the heterologous polypeptide is an epitope tag or an Fc region of an immunoglobulin, which is described in the specification at page 53, lines 15-36.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection presented for review on this appeal are:

1. Whether claims 27-29 and 32-34 are supported by a substantial, specific, and credible utility or a well-established utility, in compliance with 35 U.S.C. § 101?
2. Whether one of ordinary skill in the art would know how to use the polypeptides of claims 27-29 and 32-34, in compliance with 35 U.S.C. § 112, ¶ 1?
3. Whether claims 27-29 and 32-34 are anticipated by Botstein et al (WO 99/3517, published 7/15/99) because claims 27-29 and 32-34 are not entitled to rely on the filing date of U.S. Provisional Application Serial No. 60/113,296, filed December 22, 1998 because that application discloses no substantial, specific, and credible utility for PRO357?

VII. ARGUMENT

Although cancer remains one of the most devastating diseases affecting the world today, many battles in the fight against cancer have been won over the years through development of new techniques for diagnosing and treating cancer. One such development is the present invention, a polypeptide identified in the present application as the “PRO357 polypeptide.” In particular, the PRO357 polypeptide, encoded by a nucleic acid that is amplified in lung and colon tumors, functions as a therapeutic target and diagnostic marker for lung and colon cancer.

While recognizing that the nucleic acid encoding PRO357 is supported by a diagnostic utility for lung and colon cancers (*e.g.*, U.S. Patent No. 6,908,993), the Examiner rejects the present invention, the PRO357 polypeptide, for alleged lack of utility. The central dispute in this appeal is the utility of the PRO357 polypeptide.

A. Summary of the Argument

Claims 27-29 and 32-34 stand rejected under 35 U.S.C. §101 as allegedly lacking utility. Appellants have previously explained that patentable utility of the PRO357 polypeptides is based upon the gene amplification data for the gene encoding the PRO357 polypeptide. The specification discloses that the gene encoding PRO357 showed significant amplification, ranging from 2 to 8 fold in 26 different lung and colon primary tumors and tumor cell lines, a majority of those tumors and cell lines tested. Indeed, the specification explicitly asserts a diagnostic utility for the PRO357 polypeptides based on the significant gene amplification of PRO357.

To demonstrate the sufficiency of Appellants’ asserted utility, Appellants identified U.S. Patent No. 7,208,308, which issued to the assignee of the present application, Genentech, Inc. That patent relies on the same utility asserted by Appellants in the present application and thus provides persuasive evidence of the sufficiency of Appellants’ asserted utility. Indeed, at least 16 other patents have issued to Genentech, Inc. with utilities similar to that asserted by Appellants in the present application.

To further support the assertion of utility in the specification, Appellants have submitted numerous declarations. With their Response filed November 6, 2003, Appellants submitted the Declaration of Dr. Audrey Goddard, which explains that a gene identified as being amplified at least 2-fold by the disclosed gene amplification assay in a tumor sample relative to a normal sample is useful as a marker for the diagnosis of cancer, for monitoring cancer development and/or for measuring the efficacy of cancer therapy. With their responses submitted 11/20/05 and 6/13/06, Appellants filed the first and second declarations of Paul Polakis, which demonstrate that the gene amplification described in Example 28 more likely than not correlates with protein overexpression. Appellants also filed the Declaration of Randy Scott with their Request for Reconsideration filed 11/20/06.² The Scott Declaration demonstrates that correlation between mRNA and protein levels is art accepted. The Goddard, Polakis, and Scott declarations demonstrate that one of ordinary skill in the art would find the assertions of utility in the specification specific, substantial, and credible, *i.e.* would find that the claimed PRO357 polypeptides more likely than not have utility as markers for the diagnosis of lung and colon tumors.

The Declaration of Avi Ashkenazi, submitted 11/6/03, makes clear that even if one of ordinary skill in the art doubted the assertion of utility based on gene amplification (which Appellants do not concede), the PRO357 polypeptides still have utility because simultaneous testing of gene amplification and gene product over-expression enables more accurate tumor classification, even if the gene-product, the protein, is not over-expressed. This leads to better determination of a suitable therapy for the tumor, as demonstrated by the real-world example of the breast cancer marker HER-2/neu.

In response to this evidence, the Examiner has argued that the basis of the maintained rejection for alleged lack of utility is that gene amplification levels (genomic DNA levels)

² At page 5 of the Office Action mailed 3/7/07 the Examiner states that the Scott Declaration was not found in the file as of 11/20/06 but acknowledges the Scott Declaration was reviewed and of record.

are not predictive of mRNA or polypeptide levels. Final Office action mailed 8/18/08. In support of this assertion, the Examiner has cited references by Sen, Hittelman, Hanna, Godbout, Li, Konopka, and Pennica as evidence that DNA amplification is not *always* associated with overexpression of the gene product. Final Office Action mailed 8/18/08, at pages 4-11.

Appellants submit that the Examiner applies an improper legal standard in requiring that DNA amplification *always* be associated with overexpression of the gene product.

Appellants respectfully note that statistical certainty is not required. Rather, the evidentiary standard to be used throughout *ex parte* examination in setting forth a rejection is a preponderance of the totality of the evidence under consideration. Thus, to overcome the presumption of truth that an assertion of utility by the applicant enjoys, the Examiner must establish that it is more likely than not that one of ordinary skill in the art would doubt the truth of the statement of utility. The references cited by the Examiner neither suffice to make a *prima facie* case that more likely than not no generalized correlation exists between gene (DNA) amplification and increased polypeptide levels, nor do they outweigh the evidence demonstrating gene amplification more likely than not correlates with polypeptide overexpression. In particular, the combined teachings of Sen, Hittelman, Hanna, Godbout, Li, Konopka, and Pennica are not directed towards genes in general but to a single gene or genes within a single family and thus, their teachings cannot support a general conclusion regarding correlation between gene amplification and mRNA or protein levels.

In contrast, Appellants have submitted ample evidence to show that, in general, if a gene is amplified in cancer, it is more likely than not that the encoded protein will be expressed at an elevated level. For example, the articles by Pollack *et al.*, Orntoft *et al.*, and Hyman *et al.* (made of record in Appellants' Response filed November 10, 2004) collectively teach that in general, gene amplification increases mRNA expression. Additionally, the Declaration of Dr. Paul Polakis, principal investigator of the Tumor Antigen Project of Genentech, Inc., the assignee of the present application, shows that, in general, there is a correlation between mRNA levels and polypeptide levels. Taken

together, this evidence demonstrates that one of ordinary skill in the art would more likely than not accept Appellants' assertion of utility based on the principle that gene amplification correlates with protein overexpression. Although there are some examples that do not fit within the central dogma of molecular biology that there is a correlation between DNA, mRNA, and polypeptide levels, these instances are exceptions rather than the rule. In the majority of amplified genes, as exemplified by Orntoft *et al.*, Hyman *et al.*, Pollack *et al.*, and the Polakis Declarations, the teachings in the art overwhelmingly show that gene amplification influences gene expression at the mRNA and protein levels. Therefore, one of skill in the art would reasonably expect in this instance, based on the significant amplification data for the PRO357 gene, that the PRO357 polypeptide is concomitantly overexpressed. Thus, the claimed PRO357 polypeptides have utility in the diagnosis of cancer. Accordingly, Appellants submit that when the proper legal standard is applied, one of ordinary skill in the art would conclude that the present application discloses at least one patentable utility for the claimed PRO357 polypeptides. Appellants respectfully request the rejection of the claims for alleged lack of utility be reversed.

Further, because the rejection of claims 27-29 and 32-34 for alleged lack of enablement and anticipation is based on the Examiner's rejection of Appellants' asserted utility, the above-discussed reasons demonstrating the sufficiency of Appellant's asserted utility overcome the enablement and anticipation rejections. Appellants respectfully request the rejection of the claims for alleged lack of enablement and alleged anticipation be reversed.

B. The Utility Rejection Under 35 U.S.C. § 101 Should Be Withdrawn

In the August 18, 2008 Final Rejection, the Examiner reasserted the rejection of claims 27-29 and 32-34 under 35 U.S.C. § 101, which was first raised in the Office Action mailed August 1, 2003, alleging that the claimed invention is not supported by either a substantial asserted utility or a well established utility. This rejection is maintained despite: (1) Applicants' assertion of utility at pages 119 and 137 of the specification; (2) issuance of U.S. Patent No. 7,208,308 (assigned to the Assignee of the present application, Genentech, Inc.), which claims PRO343 polypeptides and asserts the same

utility for the PRO343 polypeptides that is asserted for the PRO357 polypeptides claimed in the present application; (3) issuance of 16 other patents (assigned to Genentech, Inc.) that assert a utility similar to that asserted here; (4) declarations from numerous experts, including Audrey Goddard, Ph.D., Paul Polakis, Ph.D., Randy Scott, Ph.D., and Avi Ashkenazi, Ph.D., explaining why the present invention is supported by a specific, substantial, and credible utility; (5) citation to and reliance on numerous articles demonstrating Appellants' asserted utility is more likely than not; and (6) Appellants' arguments explaining why all of the above evidence demonstrates the utility of the present invention.

The final rejection identifies the remaining issue as whether data demonstrating PRO357 gene amplification makes it more likely than not that the protein encoded by the gene is overexpressed. Office Action mailed 8/18/08. In support of this rejection, the Examiner relies on references by Sen, Hittelman, Godbout, Li, Konopka, and Pennica and argues that one of ordinary skill in the art would know that amplified levels of PRO357 DNA do not necessarily correlate to overexpression of the encoded PRO357 polypeptide.

Appellants respectfully disagree. As a preliminary matter, Appellants respectfully submit that it is not a legal requirement to establish a necessary correlation between an increase in the copy number of the DNA and protein expression levels that would correlate to the disease state, nor is it imperative to find evidence that DNA amplification is "always" associated with overexpression of the gene product. As discussed below, the evidentiary standard to be used throughout *ex parte* examination of a patent application is a preponderance of the totality of the evidence under consideration. Accordingly, the question is not whether a necessary or even strong correlation between an increase in copy number and protein expression levels exists, but whether it is more likely than not that a person of ordinary skill in the pertinent art would recognize such a positive correlation. Appellants respectfully submit that when the proper evidentiary standard is applied, a correlation must be acknowledged.

Indeed, in rejecting Appellants' assertions of utility, Appellants' arguments and evidence demonstrating utility, and the Goddard, Polakis, Scott and Ashkenazi declarations, the

Examiner has set the standard for satisfying the utility requirement too high. Under the proper utility standard, Applicants have demonstrated that the present invention is supported by a specific, substantial, and credible utility. For example, during prosecution Applicants cited numerous patents and art references which indicate that one of ordinary skill in the art would not have reasonably questioned the utility asserted at pages 119 and 137 of the specification. The references relied on by the Examiner, Sen, Hittelman, Hanna, Godbout, Li, Konopka, and Pennica do not outweigh the evidence relied on by Appellants. Indeed, the evidence relied on by Appellants demonstrates that consistent with the standards set forth in the *Revised Interim Utility Guidelines Training Materials*, <http://www.uspto.gov/web/offices/pac/utility/utilityguide.pdf>), the present invention is supported by a specific, substantial, credible utility, and well-established utility.

1. The Legal Standard for Utility

According to 35 U.S.C. § 101:

Whoever invents or discovers any new and *useful* process, machine, manufacture, or composition of matter, or any new and *useful* improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title. (Emphasis added.)

In interpreting the utility requirement, in *Brenner v. Manson*, 383 U.S. 519 (1966), the Supreme Court held that the *quid pro quo* contemplated by the U.S. Constitution between the public interest and the interest of the inventors required that a patent applicant disclose a "substantial utility" for his or her invention, i.e. a utility "where specific benefit exists in currently available form." *Id.* at 534.

Later, in *Nelson v. Bowler*, 626 F.2d 853 (CCPA 1980), the CCPA acknowledged that tests evidencing pharmacological activity of a compound may establish practical utility, even though they may not establish a specific therapeutic use. The court held that "since it is crucial to provide researchers with an incentive to disclose pharmaceutical activities in as many compounds as possible, we conclude adequate proof of any such activity constitutes a showing of practical utility." *Id.* at 856.

In *Cross v. Iizuka*, 753 F.2d 1047 (Fed. Cir. 1985), the CAFC reaffirmed *Nelson*, and added that *in vitro* results might be sufficient to support practical utility, explaining that "*in vitro* testing, in general, is relatively less complex, less time consuming, and less expensive than *in vivo* testing. Moreover, *in vitro* results with the particular pharmacological activity are generally predictive of *in vivo* test results, i.e. there is a reasonable correlation there between." *Id.* at 1050. The court perceived "[n]o insurmountable difficulty" in finding that, under appropriate circumstances, "*in vitro* testing, may establish a practical utility." *Id.*

This well established case law is clearly reflected in the Utility Examination Guidelines ("Utility Guidelines"), 66 Fed. Reg. 1092 (2001), which acknowledge that an invention complies with the utility requirement of 35 U.S.C. §101, if it has at least one asserted "specific, substantial, and credible utility" or a "well-established utility." Under the Utility Guidelines, a utility is "specific" when it is particular to the subject matter claimed. For example, it is generally not enough to state that a nucleic acid is useful as a diagnostic without also identifying the conditions that are to be diagnosed.

In explaining the "substantial utility" standard, M.P.E.P. §2107.01 cautions, however, that Office personnel must be careful not to interpret the phrase "immediate benefit to the public" or similar formulations used in certain court decisions to mean that products or services based on the claimed invention must be "currently available" to the public in order to satisfy the utility requirement. "Rather, any reasonable use that an applicant has identified for the invention that can be viewed as providing a public benefit should be accepted as sufficient, at least with regard to defining a 'substantial' utility." MPEP § 2107.01. Indeed, the Guidelines for Examination of Applications for Compliance With the Utility Requirement, MPEP § 2107 II (B)(1), gives the following instruction to patent examiners: "If the applicant has asserted that the claimed invention is useful for any particular practical purpose . . . and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility."

2. The Examiner Sets the Utility Bar Too High

At pages 119 and 137 of the specification, Applicants assert a specific, substantial, and credible utility for the claimed invention:

Amplification is associated with overexpression of the gene product, indicating that the polypeptides are useful targets for therapeutic intervention in certain cancers such as colon, lung, breast and other cancers. Therapeutic agents may take the form of antagonists of PRO327, PRO344, PRO357, PRO357 aor (sic) PRO715 polypeptide, for example, murine-human chimeric, humanized or human antibodies against a PRO327, PRO344, PRO357, PRO357, or PRO715 polypeptide. These amplifications are useful as diagnostic markers for the presence of a specific type of tumor.

(p.119)

The polypeptides encoded by the DNAs tested have utility as diagnostic markers for determining the presence of tumor cells in lung and/or colon tissue samples.

(p.137)

An applicant's assertion of utility creates a presumption of utility sufficient to satisfy the utility requirement of 35 U.S.C. § 101, "unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope." *In re Langer*, 183 USPQ 288, 297 (CCPA 1974). See also *In re Jolles*, 206 USPQ 885 (CCPA 1980); *In re Irons*, 144 USPQ 351 (9165); *In re Sichert*, 196 USPQ 209, 212-213 (CCPA 1977).

Compliance with 35 U.S.C. § 101 is a question of fact. *Raytheon v. Roper*, 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983) cert. denied, 469 U.S. 835 (1984). The evidentiary standard to be used throughout *ex parte* examination in setting forth a rejection is a preponderance of the totality of the evidence under consideration. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Thus, to overcome the presumption of truth that an assertion of utility by the applicant enjoys, the Examiner must establish that it is more likely than not that one of ordinary skill in the art would doubt the truth of the statement of utility.

Further, statistical certainty regarding Appellants' assertion of utility is not required to satisfy 35 U.S.C. § 101. *Nelson v. Bowler*, 626 F.2d 853, 856-857, 205 USPQ 881, 883-884 (CCPA 1980). Where an applicant has specifically asserted that an invention has a particular utility, that assertion cannot simply be dismissed as "wrong" even where there may be some reason to question the assertion. MPEP § 2107.02. Significantly, a 35 U.S.C. § 101 rejection should only be sustained where the asserted utility violates a scientific principle or is *wholly inconsistent* with contemporary knowledge in the art. *In re Gazave*, 379 F.2d 973, 978, 154 U.S.P.Q. 92, 96 (CCPA 1967) (emphasis added). Indeed, the United States Court of Appeals for the Federal Circuit acknowledges that to fail to satisfy the utility requirement, an invention must be "totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed.Cir. 1992) ("To violate Section 101 the claimed device must be totally incapable of achieving a useful result"); *see also Fuller v. Berger*, 120 F. 274, 275 (7th Cir. 1903) (test for utility is whether invention "is incapable of serving any beneficial end").

Appellants' asserted utility should be accepted because it is squarely within the teaching of leading textbooks in the field, and is supported by numerous references and the declarations of skilled experts. This evidence is sufficient to demonstrate utility because an applicants' evidence rebutting the Office's rejection for lack of utility does not need to absolutely prove that the asserted utility is real. Rather, the evidence only needs to be reasonably indicative of the asserted utility. Moreover, this evidence demonstrates that Appellants' asserted utility does not violate any scientific principle, nor is it wholly inconsistent with contemporary knowledge in the art, nor are the claimed PRO357 polypeptides totally incapable of achieving a useful result. Consideration of the totality of the evidence discussed below clearly demonstrates these points. Thus, the maintained rejection of the present claims for alleged lack of utility is improper and should be withdrawn.

3. The Totality of the Evidence Demonstrates One of Ordinary Skill in the Art Would Accept Appellants' Asserted Utility

Since Appellants have asserted a utility for the claimed polypeptides, the burden shifted to the Examiner to establish a *prima facie* case of lack of utility. MPEP § 2107.02.

Appellants do not concede that the Examiner has established a *prima facie* case of lack of utility but even if a *prima facie* case of lack of utility were established, that showing is overcome by the totality of the evidence, which, as shown below, demonstrates that it is more likely than not that PRO357 gene amplification correlates with PRO357 polypeptide overexpression.

a. It is a Well-Accepted, Scientific Principle that DNA is Transcribed into RNA which is Translated into Protein.

According to Genes V, a *central dogma* of molecular biology is that genes are perpetuated as nucleic acid sequences, but function by being expressed in the form of proteins. Thus, genetic information is perpetuated by replication where a double-stranded nucleic acid is duplicated to give identical copies. These copies are then expressed by a two-stage process. First, transcription generates a single-stranded RNA identical in sequence with one of the strands of the duplex DNA. This RNA strand is then translated such that the nucleotide sequence of the RNA is converted into the sequence of amino acids comprising a protein. *See* Lewin, Benjamin. *Genes V*. 1994. Oxford University Press, NY, NY. p. 163. *Genes VI*, the next edition of Lewin's text, further explains that "having acknowledged that control of gene expression can occur at multiple stages, and that production of RNA cannot inevitably be equated with production of protein, it is clear that the overwhelming majority of regulatory events occur at the initiation of transcription." *Genes VI*. 1997. Oxford University Press, NY, NY. pp. 847-848 (Emphasis added). *See* Amendment and Request for Reconsideration filed 12/11/06, Exhibit 1.

Thus, those of skill in the art generally accept that gene expression levels correlate to protein expression levels absent specific events such as translation regulation, post-translation processing, protein degradation, protein isolating errors, etc. *See* Orntoft *et*

al., "Genome-wide study of gene copy numbers, transcripts, and protein levels in pairs of non-invasive and invasive human transitional cell carcinomas." 2002. *Molecular & Cellular Proteomics* 1, 37-45.

Indeed, another leading treatise, Molecular Biology of the Cell (4th ed. 2002) illustrates the basic principle that there is a correlation between increased gene expression and increased protein expression in Figure 6-3 on page 302. *See* Amendment and Request for Reconsideration filed 12/11/06, Exhibit 1. The accompanying text states that "a cell can change (or regulate) the expression of each of its genes according to the needs of the moment – *most obviously by controlling the production of its mRNA.*" Cell 4th at 302 (Emphasis added). Similarly, Figure 6-90 on page 364 of Molecular Biology of the Cell (4th ed) illustrates the path from gene to protein. The accompanying text states that while potentially each step can be regulated by the cell, "the initiation of transcription is the most common point for a cell to regulate the expression of each of its genes." Cell 4th at 364 (emphasis added). This point is repeated on page 379, where the authors state that of all the possible points for regulating protein expression, "[f]or most genes transcriptional controls are paramount." Cell 4th at 379 (Emphasis added).

Further, Meric *et al.*, *Molecular Cancer Therapeutics*, Vol. 1, 971-979 (2002) states the following:

The **fundamental principle** of molecular therapeutics in cancer is to exploit the differences in gene expression between cancer cells and normal cells...[M]ost efforts have concentrated on identifying differences in gene expression at the level of mRNA, which can be attributable to either DNA amplification or to differences in transcription. Meric *et al.* at 971 (Emphasis added).

See Request for Reconsideration filed 11/20/06, Exhibit 1. Appellants respectfully submit that, as these leading treatises demonstrate, those of ordinary skill in the art would not be focusing on differences in gene expression between cancer cells and normal cells if there were no correlation between gene expression and protein expression.

Therefore, Appellants' assertion that the claimed polypeptides are supported by a diagnostic utility because they are encoded by nucleic acids that are amplified in lung and colon tumors does not violate scientific principles.

b. Appellants' Asserted Utility Relies on the Well-Accepted Scientific Principle that Gene Amplification Correlates with Protein Overexpression

It was well known in the art at the time the invention was made that gene amplification is an essential mechanism for oncogene activation. Indeed, the working hypothesis among those skilled in the art is that if a gene is amplified in cancer, the encoded protein is likely to be expressed at an elevated level. Based on that, Appellants' asserted that the PRO357 polypeptides, which are encoded by a gene amplified in lung and colon tumors, would be useful as "targets for therapeutic intervention in certain cancers such as colon, lung, breast and other cancers and diagnostic determination of the presence of those cancers." Specification at pages 119 and 137.

Appellants' assertion of utility is based on the overwhelming evidence from the gene amplification data disclosed in the specification, which clearly indicates that the PRO357 nucleic acid is significantly amplified in cancerous tissue compared to normal tissue. Specifically, as explained in Example 28, the inventors identified PRO357 by isolating genomic DNA from a variety of primary cancers and cancer cell lines that are listed in Table 10, including primary lung and colon tumors of the type and stage indicated in Table 9. As a negative control, DNA was isolated from the cells of ten normal healthy individuals, which was pooled. Gene amplification was monitored using real-time quantitative TaqMan™ PCR. Table 10 shows the resulting gene amplification data. Further, Example 28 explains that the results of TaqMan™ PCR are reported in ΔCt units, wherein one unit corresponds to one PCR cycle or approximately a 2-fold amplification relative to control, two units correspond to 4-fold amplification, 3 units to 8-fold amplification etc.

Appellants respectfully submit that a ΔCt value of at least 1.0 was observed for PRO357 in at least 26 of the tumors and tumor cell lines listed in Table 10. Indeed, PRO357 showed ΔCt values of approximately 1.05 -3.15 in 26 lung or colon tumors, which

demonstrates at least 2.00-8.00 fold amplification. Specifically, the ΔCt values reported for PRO357 in Example 28 demonstrate that PRO357 is significantly amplified in approximately 93% of lung tumor tissues and approximately 75% of colon tumor tissues listed in Table 9. Accordingly, the present specification clearly discloses overwhelming evidence that the gene encoding the PRO357 polypeptide is significantly amplified in a number of lung and colon tumors. Based on this data, one of ordinary skill in the art would accept that since the PRO357 gene is amplified, the PRO357 polypeptide would be more likely than not overexpressed. Thus, one of ordinary skill in the art would find it credible that the PRO357 polypeptide is a useful target as a cancer marker for diagnostic determination of the presence of lung and colon tumors.

c. Acceptance of the Same Utility as that Asserted by Appellants to Issue the '308 Patent Demonstrates the Sufficiency of Appellants' Asserted Utility

The USPTO has recognized that Appellants' asserted utility is sufficient by issuing U.S. Patent No. 7,208,308 (the "'308 patent") with claims supported by the same utility as the utility asserted herein. *See, e.g.* claim 1 of the '308 patent, which states that the claimed polypeptide is encoded by a nucleic acid that is amplified in lung or colon tumors.

Issuance of the '308 patent is direct and persuasive evidence that Appellants' assertion of utility satisfies the requirements of 35 U.S.C. § 101. In particular, the protocols and procedures of the gene amplification experiment in the '308 patent (Example 92) and the present application (Example 28) are identical. In addition, the ΔCt values resulting from these gene amplification experiments are similar: 1.0 – 3.82 ΔCt in the '308 patent versus 1.05 – 3.51 ΔCt in the present application.

The Examiner however, alleged issuance of the '308 patent does not provide persuasive evidence that the USPTO accepts Appellants' asserted utility. However, in response to a rejection for alleged lack of utility, the Applicant of the '308 patent asserted the same utility as that asserted by Appellants: "Applicants have asserted utility for the instantly claimed PRO343 polypeptide based on amplification of the PRO343 gene in the 'gene amplification assay' described in the instant specification in Example 92." *See '308 Patent, Amendment*

and Response filed 11/9/05, at page 4. Additionally, the Notice of Allowability for the '308 patent indicates it issued in response to the amendment filed August 15, 2006. *See* '308 Patent, Notice of Allowability, mailed 10/19/06. In the August 15, 2006 Amendment, the Applicants of the '308 patent submitted the Declaration of Randy Scott, Ph.D. *See* '308 patent, Amendment and Response, mailed 8/15/06. In his declaration, Dr. Scott testified about the utility of DNA microarrays, such as that used in Example 92 of the '308 patent, to identify amplified genes. Dr. Scott also testified that in his experience, which includes more than 15 years of personal experience with DNA microarray techniques, gene amplification more likely than not correlates with overexpression of mRNA and ultimately with polypeptide overexpression. *See* '308 patent, Amendment and Response, mailed 8/15/06. Thus, Appellants respectfully submit that the '308 patent issued because the USPTO accepted utility of a polypeptide encoded by an amplified gene.

In addition to relying on the same utility as the '308 patent, during prosecution of the present application, Appellants submitted the same declaration of Randy Scott that was submitted during prosecution of the '308 patent. *See* Request for Reconsideration filed 11/20/06. The '308 patent issued because the PTO found the Scott Declaration, along with the other evidence presented during prosecution of the '308 patent, demonstrated that gene amplification more likely than not correlated with mRNA and polypeptide overexpression. As the same evidence has been submitted in support of Appellants' asserted utility, Appellants respectfully maintain that issuance of the '308 patent is persuasive evidence that the present claims are supported by a specific, substantial, and adequate utility and thus, satisfy the requirements of 35 U.S.C. § 101.

The Examiner however, further alleged that issuance of the '308 patent cannot support Appellants' asserted utility because each application is examined on its own merits. Office Action mailed 8/31/07, page 2. While Appellants acknowledge that each application is examined on its own merits, Appellants maintain that allowance of similar claims is persuasive evidence where those claims are allowed based on the same assertions of utility, and where that same assertion relies on similar data and evidence. Indeed, the Court of Customs and Patent Appeals recognized that "similar claims allowed by the Patent Office

tribunals furnish evidence of what features those tribunals regard as patentable.” *In re Schecter and LaForge*, 205 F.2d 185, 90 USPQ 144, 150 (CCPA 1953).

d. Issuance of 16 Other Patents Based on a Similar Utility Also Demonstrates the Sufficiency of Appellants’ Asserted Utility

Moreover, the USPTO has acknowledged on more than one occasion that a utility similar to Appellants’ asserted utility is sufficient to satisfy the utility requirement of 35 U.S.C. § 101. In addition to issuing the ’308 patent, the USPTO has issued 16 other patents, all assigned to Genentech, Inc., assignee of the present application, based on similar assertions of utility. *See e.g.*, U.S. Patent Nos. 7,276,577 (Issued 10/2/07); 7,343,721 (Issued 3/18/08); 7,282,566 (Issued 10/16/07); 7,279,551 (Issued 10/9/07); 7,288,626 (Issued 10/30/07); 7,282,559 (Issued 10/16/07); 7,297,764 (Issued 11/20/07); 7,282,560 (Issued 10/16/07); 7,288,627 (Issued 10/30/07); 7,329,730 (Issued 2/12/08); 7,297,768 (Issued 11/20/07); 7,319,137 (Issued 1/15/08); 7,282,569 (Issued 10/16/07); 7,291,708 (Issued 11/6/07); 7,291,706 (Issued 11/6/07); and 7,348,405 (Issued 3/25/08). Issuance of these 16 patents, which were examined by at least 10 different examiners, is direct evidence that Appellants’ assertion of utility satisfies the requirements of 35 U.S.C. § 101.

The below claim, which is similar to pending claim 27, issued in U.S. Patent No. 7,276,577:

1. An isolated polypeptide comprising:
 - a. the amino acid sequence of the polypeptide of SEQ ID NO:14;
 - b. the amino acid sequence of the polypeptide of SEQ ID NO: 14, lacking its associated signal peptide; or
 - c. the amino acid sequence of the polypeptide encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 203577.

Prior to issuance, this claim was finally rejected and the Assignee of U.S. Patent No. 7,276,577, Genentech, Inc. who is also assignee of the present application, appealed that final rejection. On appeal, the Assignee argued that the above claim was supported by a

specific and substantial utility based on microarray data demonstrating amplification of SEQ ID NO:14 in colon, lung and prostate tumors compared to normal tissue. In response, the USPTO Board of Patent Appeals and Interferences (hereinafter, the “Board”) reversed the Examiner’s rejection for lack of utility and found “[t]he use of PRO1866 polypeptide as a cancer marker is sufficient to demonstrate utility.” *See* Decision of the USPTO Board of Patent Appeals and Interferences, Appeal No. 2006-1469 at pages 9-10. Appellants respectfully submit that finding of the Board demonstrates that the claimed polypeptide, PRO357, also has a sufficient utility, particularly as a cancer marker. Indeed, Appellants assert this specific and substantial utility at paragraph 703 of the present application:

[0703] This example shows that the PRO327-, PRO344-, PRO357- PRO357-, and PRO715-encoding genes are amplified in the genome of certain human lung, colon and/or breast cancers and/or cell lines. Amplification is associated with overexpression of the gene product, indicating that the polypeptides are useful targets for therapeutic intervention in certain cancers such as colon, lung, breast and other cancers. . . . **These amplifications also are useful as diagnostic markers for the presence of a specific type of tumor type.**

Emphasis added.

Partly in response to this evidence, the Examiner acknowledged that mRNA levels are predictive of polypeptide levels. Office action mailed 1/22/08, at pages 8-9. Appellants respectfully note the Board agrees with this position. Specifically, in reversing the Examiner’s rejection of the claims (for alleged lack of utility) ultimately issued in U.S. Patent No. 7,276,577, the Board stated, “[a]s demonstrated by the Polakis and Smith Declarations, however, there is a strong correlation between mRNA levels and protein expression.” Decision of the USPTO Board of Patent Appeals and Interferences, Appeal No. 2006-1469 at page 9. As discussed more fully below, Appellants submitted the same Polakis Declarations in this case that were submitted during prosecution of U.S. patent No. 7,276,577. *See* Request for Reconsideration filed 11/25/05.

e. **The Numerous Declarations Submitted in Support of Appellants' Asserted Utility Demonstrate One of Ordinary Skill in the Art Would Accept Appellants' Assertion of Utility for PRO357 Polypeptides**

Appellants have submitted numerous declarations that demonstrate the claimed polypeptides are supported by an adequate utility.

(1) **The Goddard Declaration**

In support of Appellants' assertion that the Example 28 demonstrates significant gene amplification of the PRO357 nucleic acid, Appellants submitted with their Response filed November 6, 2003, a Declaration by Dr. Audrey Goddard. Appellants particularly draw the Board's attention to page 3 of the Goddard Declaration which clearly states that:

It is further my considered scientific opinion that an at least **2-fold increase** in gene copy number in a tumor tissue sample relative to a normal (*i.e.*, non-tumor) sample is **significant** and useful in that the detected increase in gene copy number in the tumor sample relative to the normal sample serves as a basis for using relative gene copy number as quantitated by the TaqMan PCR technique as a diagnostic marker for the presence or absence of tumor in a tissue sample of unknown pathology. Accordingly, a gene identified as being amplified at least 2-fold by the quantitative TaqMan PCR assay in a tumor sample relative to a normal sample is **useful as a marker for the diagnosis of cancer**, for monitoring cancer development and/or for measuring the efficacy of cancer therapy. (Emphasis added).

As indicated above, the gene encoding the PRO357 polypeptide shows significantly higher than a two-fold amplification in a majority of the tumors and tumor cell lines tested. In addition, the Goddard Declaration clearly establishes that the TaqMan real-time PCR method described in Example 28 has gained wide recognition for its versatility, sensitivity and accuracy, and is in extensive use for the study of gene amplification. The facts disclosed in the Goddard Declaration also confirm that based upon the gene amplification results, one of ordinary skill would find it credible that PRO357 is a diagnostic marker of lung and colon cancer.

(2) The Polakis Declarations

Appellants also submitted two declarations by Paul Polakis, Ph.D. in support of the assertion of utility. In his first declaration, Dr. Polakis declared that in general, there is a correlation between mRNA levels and polypeptide levels. See Response and Request for Reconsideration filed 10/20/05. More specifically, Dr. Polakis explains:

4. In the course of the research conducted by Genentech's Tumor Antigen Project . . . using microarray analysis, we have identified approximately 200 gene transcripts that are present in human tumor cells at significantly higher levels than in corresponding normal human cells. To date, we have generated antibodies that bind to about 30 of the tumor antigen proteins expressed from these differentially expressed gene transcripts and have used these antibodies to quantitatively determine the level of production of these tumor antigen proteins in both human cancer cells and corresponding normal cells. We have then compared the levels of mRNA and protein in both the tumor and normal cells analyzed.
5. From the mRNA and protein expression analyses described in paragraph 4 above, we have observed that there is a strong correlation between changes in the level of mRNA present in any particular cell type and the level of protein expressed from that mRNA in that cell type. In approximately 80% of our observations we have found that increases in the level of a particular mRNA correlates with changes in the level of protein expressed from that mRNA when human tumor cells are compared with their corresponding normal cells.
6. Based upon my own experience accumulated in more than 20 years of research, including the data discussed in paragraphs 4 and 5 above and my knowledge of the relevant scientific literature, it is my considered scientific opinion that for human genes, an increased level of mRNA in a tumor cell relative to a normal cell typically correlates to a similar increase in abundance of the encoded protein in the tumor cell relative to the normal cell. In fact, it remains a central dogma in molecular biology that increased mRNA levels are predictive of corresponding increased levels of the encoded protein.

Significantly, Dr. Polakis declared that “in approximately 80%” of the cases observed in connection with the Tumor Antigen Protein, increases in the mRNA levels correlated with changes in the levels of protein expression. Thus, this is direct evidence that gene amplification more likely than not correlates with protein overexpression. Indeed, according to MPEP § 2107, the Examiner “must accept an opinion from a qualified expert that is based on relevant facts whose accuracy is not being questioned; it is

improper to disregard the opinion solely because of a disagreement over the significance or meaning of the facts offered.” (emphasis added).

With the Response and Request for Continued Examination filed June 13, 2006, Appellants submitted a second Declaration of Paul Polakis that included data establishing that more than 90% of the genes identified as being amplified in the Tumor Antigen Project referenced in the Polakis Declarations (Example 28 in the present application is based on the Tumor Antigen Project referenced in the Polakis Declarations) were detectably overexpressed in human tissue compared to normal tissue at both the mRNA and protein levels. More specifically, Appellants direct the Board’s attention to paragraph 5 of the Second Declaration of Dr. Polakis, where Dr. Polakis declares that the data provided therein indicates that:

of the 31 genes identified as being detectably overexpressed in human tumor tissue as compared to normal tissue at the mRNA level, 28 of them (i.e., greater than 90%) are also detectably overexpressed in human tumor tissue as compared to normal human tissue at the protein level. As such, in cases where we have been able to quantitatively measure both (i) mRNA and (ii) protein levels in both (i) tumor tissue and (ii) normal tissue, we have observed that in the vast majority of cases, there is a very strong correlation between increases in mRNA expression and increases in the level of protein encoded by that mRNA.

Second Declaration of Paul Polakis submitted June 13, 2006, at Paragraph 5, Exhibit B.

The Polakis Declarations are persuasive evidence of how one of ordinary skill in the art would view Applicant’s assertion of utility, which is based on the art accepted correlation between gene amplification and protein overexpression.

(3) The Scott Declaration

Appellants also submitted a declaration by Randy Scott, Ph.D., in support of their assertion of utility for the PRO357 polypeptides. *See* Request for Reconsideration filed 11/20/06. Dr. Scott was a co-founder of Incyte Pharmaceuticals, Inc., the world’s first genomic information business, and is currently the Chairman and Chief Executive Officer of Genomic Health, Inc., a life science company located in Redwood City, California, which provides individualized information on the likelihood of disease recurrence and response to certain types of therapy using gene expression profiling. Based on his more

than 15 years of personal experience with the DNA microarray technique and its various uses in the diagnostic and therapeutic fields, and his familiarity with the relevant art, *Dr. Scott unequivocally confirms that, as a general rule, there is a good correlation between mRNA and protein levels in a particular tissue.* Appellants respectfully direct the Board's attention to paragraph 10 of the Scott Declaration:

One reason for the success and wide-spread use of the DNA microarray technique, which has led to the emergence of a new industry, is that generally there is a good correlation between mRNA levels determined by microarray analysis and expression levels of the translated protein. Although there are some exceptions on an individual gene basis, it has been a consensus in the scientific community that elevated mRNA levels are good predictors of increased abundance of the corresponding translated proteins in a particular tissue. Therefore, diagnostic markers and drug candidates can be readily and efficiently screened and identified using this technique, without the need to directly measure individual protein expression levels.

(emphasis added).

In the Office action mailed March 7, 2007, the Examiner rejected the Scott Declaration as unpersuasive because allegedly the Scott Declaration does not provide any evidence of PRO357 mRNA or polypeptide expression and is thus, "of no avail." Office action mailed 3/7/07, at page 6. Appellants respectfully disagree. In his declaration, Dr. Scott unequivocally confirms that, as a general rule, there is a good correlation between mRNA and protein levels in a particular tissue. This conclusion, which states a general rule observed over time is based on the stated facts that Dr. Scott has more than 15 years experience with microarray technologies, and in his experience, Dr. Scott has noticed a good correlation. Even though the Scott Declaration does not specifically address PRO357, Appellants respectfully submit that when the Scott Declaration is considered with the other evidence cited by Appellants supporting the asserted utility, as it must be, it is clear that Appellants have met the burden of establishing a utility for the claimed polypeptide. Indeed, as Appellants noted above, the Scott Declaration was submitted along with the response that led to issuance of the '308 patent.

(4) The Ashkenazi Declaration

Finally, Appellants submitted declaratory evidence demonstrating Appellants' claimed invention is supported by an adequate utility even if the Board finds one of ordinary skill in the art would not find it more likely than not that gene amplification correlates with protein overexpression (a point which Appellants do not concede). Appellants submitted a declaration by Avi Ashkenazi, Ph.D. and an article by Hanna and Mornin (Pathology Associates Medical Laboratories, August 1999) with their Amendment and Response filed 11/6/03, which demonstrates utility of the claimed polypeptides because simultaneous testing of gene amplification and gene product over-expression enables more accurate tumor classification, even if the gene-product, the protein, is not over-expressed. As Dr. Ashkenzi explains, this leads to better determination of a suitable therapy for the tumor as demonstrated by the real-world example of the breast cancer marker HER-2/neu. Appellants respectfully submit that this is a substantial utility (separate from the substantial utility based on correlation between gene amplification and protein overexpression) adequate to satisfy the utility requirement of 35 U.S.C. § 101. Indeed, according to § 2107 of the MPEP, "any reasonable use that an applicant has identified for the invention that can be viewed as providing a public benefit should be accepted as sufficient, at least with regard to defining a "substantial" utility.

f. Utility of the Claimed Polypeptides is Not Inconsistent with Knowledge in the Art

In addition to providing evidence of issued patents relying on the same or similar assertions of utility, numerous declarations establishing the significance of the PRO357 gene amplification and correlation of mRNA and polypeptide expression levels, throughout prosecution Appellants have cited more than 140 references demonstrating that gene amplification more likely than not correlates with protein overexpression. *See, e.g.*, Request for Reconsideration mailed 11/20/06. These references cited by Appellants demonstrate that one of ordinary skill in the art would reasonably conclude that the present invention is supported by a specific, substantial, and credible utility.

(1) Gene Amplification More Likely Than Not Correlates with mRNA Overexpression

Indeed, references by Pollack *et al.*, Orntoft *et al.*, Hyman *et al.*, Varis, Bermont, Jares and Fan demonstrate that gene amplification more likely than not correlates with increased mRNA expression. Specifically, Pollack *et al.* profiled DNA copy number alterations across 6,691 mapped human genes in 44 breast tumors and 10 breast cancer cell lines and reported that microarray measurements of mRNA levels revealed remarkable degrees to which variation in gene copy number contributes to variation in gene expression in tumor cells. See Pollack *et al.*, "Microarray analysis reveals a major direct role of DNA copy number alteration in the transcriptional program of human breast tumors." 2002. *PNAS*, 99(20):12963-12968. Pollack *et al* further report that their findings that DNA copy number plays a role in gene expression levels are generalizable. Thus significantly, "[t]hese findings provide evidence that widespread DNA copy number alteration can lead directly to global deregulation of gene expression, which may contribute to the development or progression of cancer."

In particular, Pollack *et al.* report a parallel analysis of DNA copy number and mRNA levels. Pollack *et al.* found that "[t]he overall patterns of gene amplification and elevated gene expression are *quite concordant*, i.e., a significant fraction of highly amplified genes appear to be correspondingly highly expressed." (emphasis added). Specifically, of 117 high-level DNA amplifications 62% were associated with at least moderately elevated mRNA levels and 42% were found associated with comparably highly elevated mRNA levels.

Orntoft *et al.* report similar findings in "Genome-wide study of gene copy numbers, transcripts, and protein levels in pairs of non-invasive and invasive human transitional cell carcinomas." 2002. *Molecular & Cellular Proteomics* 1.1, 37-45. Initially, Orntoft *et al.* note that "[h]igh throughput array studies of the breast cancer cell line BT474 ha(ve) suggested that there is a correlation between DNA copy numbers and gene expression in highly amplified areas (), and studies of individual genes in solid tumors have revealed a good correlation between gene dose and mRNA or protein levels in the case of c-erb-B2, *cyclin d1*, *ems1*, and N-myc." Orntoft *et al.*, at p. 37.

Specifically, Orntoft *et al.* used 2D-PAGE analysis on four breast tumor tissue samples to determine correlation between genomic and protein expression levels of 40 well resolved, known proteins. Orntoft reported that “[i]n general there was a *highly significant correlation* ($p<0.005$) between mRNA and protein alterations (). Only one gene showed disagreement between transcript alteration and protein alteration.” (emphasis added). Orntoft *et al.*, at p. 42. Additionally, Orntoft *et al.* report that “11 chromosomal regions where CGH showed aberrations that corresponded to the changes in transcript levels also showed corresponding changes in the protein level ().” Orntoft *et al.*, at p. 43. The regions examined by Orntoft include genes encoding proteins that are often found altered in bladder cancer.

Orntoft *et al.* note that their study reports a *striking correspondence* between DNA copy number, mRNA expression and protein expression. Orntoft *et al.*, further note that any observed discrepancies in correlation may be attributed to translation regulation, post-translation processing, protein degradation or some combination of these.

However, the Examiner rejected Appellants’ reliance on Orntoft because allegedly Orntoft only compared the “levels of about 40 well-resolved and focused *abundant* proteins.” Office action mailed 8/18/08 at page 5. *Id.* Appellants respectfully disagree. Appellants rely on Orntoft for the teaching that in general gene amplification correlates with polypeptide overexpression. Orntoft clearly teaches this correlation as discussed above.

Similarly Hyman *et al.*, compared DNA copy numbers and mRNA expression of over 12,000 genes in breast cancer tumors and cell lines, and found that there was evidence of a prominent global influence of copy number changes on gene expression levels. See Hyman *et al.*, “Impact of DNA amplification on gene expression patterns in breast cancer.” 2002. *Cancer Research*, 62:62-40-6245.

The Examiner also disagrees with Appellants’ reliance on Hyman and argued that “[s]ince Hyman et al found that less than half of the amplified genes were overexpressed at the mRNA level” Hyman supports the Office’s position. Office action mailed 8/18/08, at page 5. Appellants respectfully disagree. Hyman reports that “[t]hroughout the

genome, both high- and low-level copy number changes had a substantial impact on gene expression, with 44% of the highly amplified genes showing overexpression.” Abstract. Hyman concludes that the disclosed analysis provided: “(a) evidence of a prominent global influence of copy number changes on gene expression levels; (b) a high-resolution map of 24 independent amplicons in breast cancer; and (c) identification of a set of 270 genes, the overexpression of which was statistically attributable to gene amplification.” Page 5. Hence, Hyman teaches gene amplification correlates with protein overexpression.

Varis and Bermont are yet further examples that utility of the present invention based on a correlation between gene amplification and protein overexpression is not wholly inconsistent with knowledge in the art. Varis *et al.*, carried out a comprehensive analysis of gene copy number and expression levels of 636 chromosome 17-specific genes in gastric cancer. See Varis *et al.*, “Targets of gene amplification and overexpression at 17q in gastric cancer.” *Cancer Res.* 2002. 1;62(9):2625-9. Specifically, Varis *et al.* report that analysis of DNA copy number changes by comparative genomic hybridization on a cDNA microarray revealed increased copy numbers of 11 genes, 8 of which were found to be overexpressed in the expression analysis. Thus, Varis *et al.*, teach there is a 72% correlation between increased DNA copy number and gene expression level.

Bermont teaches that overexpression of p185 is usually associated with c-erbB-2 amplification. Specifically, Bermont reports that 100% of the overexpressed p185 protein in 106 breast cancer samples studied also displayed c-erbB-2 amplification. See Bermont *et al.*, “Relevance of p185 HER-2/neu oncoprotein quantification in human primary breast carcinoma.” *Breast Cancer Res Treat.* 2000 63(2):163-9. See also Hu *et al.*, “Profiling of differentially expressed cancer-related genes in esophageal squamous cell carcinoma (ESCC) using human cancer cDNA arrays: overexpression of oncogene MET correlates with tumor differentiation in ESCC.” *Clin Cancer Res.* 2001 7(11):3519-25 (the results of cDNA arrays showed that 13 cancer-related genes were upregulated > or = 2 fold and immunostaining results of the expression of the MET gene showed MET overexpression at the protein level, validating the cDNA arrays findings).

In the Final Office Action, the Examiner takes issue with Appellants' reliance on a reference by Jares *et al.* because allegedly Jares recognizes that correlation between gene amplification and overexpression is difficult. Final Office Action mailed 8/18/08, at pages 5-6. While Appellants acknowledge that there might be some exceptions to the general rule of correlation, Appellants maintain that Jares is relevant to the present inquiry because Jares teaches that “[a] significant association was observed between gene amplification and mRNA overexpression [of *PRAD-1*, a putative oncogene localized on chromosome 11q13 which encodes cyclin D1] ($P<0.0001$) with only 3 discordant cases (2 amplifications with no overexpression and 1 overexpressed carcinoma with no gene amplification). Furthermore, in Jares the degree of DNA amplification correlated with the levels of mRNA expression ($r=0.6$; $P = 0.024$).” Jares, et al., “*PRAD-1/Cyclin D1* Gene Amplification Correlates with Messenger RNA Overexpression and Tumor Progression in Human Laryngeal Carcinomas,” *Cancer Research*, 1994. 54:4813-4817 (Abstract). Hence, Jares provides additional evidence that gene amplification correlates with mRNA expression levels.

Similarly, the Examiner rejects Appellants reliance on Fan, which teaches “the hTERT oncogene is amplified in a significant proportion of medulloblastomas and other CNS embryonal neoplasms. This gene amplification correlates with increased expression of hTERT mRNA.” Fan et al., “hTERT Gene Amplification and Increased mRNA Expression in Central Nervous System Embryonal Tumors,” *Am. J. Path.*, 2003. 162(6):1763-1769 (Abstract). According to the Examiner, Fan is not persuasive because Fan reports no correlation between DNA, RNA, and protein levels. Appellants respectfully maintain however that Fan’s report that gene amplification levels correlate with mRNA levels is significant to the present inquiry, particularly given that the Office recognizes that mRNA levels correlate with polypeptide levels.

These references demonstrate that one of ordinary skill in the art would accept that it is more likely than not that gene amplification correlates with mRNA overexpression.

(2) mRNA Overexpression More Likely than not Correlates with Protein Overexpression

Numerous other references cited by Appellants demonstrate that mRNA overexpression more likely than not correlates with protein overexpression. Indeed, in the Office Action mailed January 22, 2008, the Examiner expressly acknowledged that mRNA levels are predictive of polypeptide levels. Although there may not always be a 100% correlation between gene amplification and protein overexpression, the above discussed references evidence that gene amplification more likely than not correlates with mRNA overexpression and the Examiner acknowledges that mRNA overexpression more likely than not correlates with protein overexpression. Indeed, Appellants note the Board also expressly recognized the latter in Decision of the USPTO Board of Patent Appeals and Interferences, Appeal No. 2006-1469 at page 9. Hence, the utility of the present invention is not wholly inconsistent with the knowledge in the art. Thus, these references provide further evidence that one of ordinary skill in the art would believe that the claimed invention is supported by a specific, substantial, and credible utility.

g. The References Relied on by the Examiner do not Outweigh the Evidence Supporting Appellants' Asserted Utility

Throughout prosecution of the present application, Appellants have overcome numerous references relied on by the Examiner including references by Haynes, Gygi, Lian, Fessler, LaBaer, chen, Hanna, Greenbaum, Winstead, Irving, etc. *See, e.g.*, Office Action mailed 1/22/08; Request for Reconsideration filed 5/12/08. In the final rejection, the Examiner relies on references by Sen, Hittelman, Hanna, Godbout, Li, Pennica, and Konopka, in an attempt to overcome Appellants' asserted utility. Appellants' respectfully disagree that these references make it more likely than not that one of ordinary skill in the art would reject Appellants' assertion of utility for the claimed PRO357 polypeptides based on amplification of the PRO357 nucleic acid.

(1) Neither Sen Nor Hittelman Demonstrate Insufficiency of Appellants' Asserted Utility

The Examiner alleges Sen addresses “[t]he *general* concept of gene amplification’s lack of correlation with mRNA/protein overexpression in cancer tissue.” Final Office Action

mailed 8/18/08, at pages 3-4. Specifically, the Examiner alleges “Sen teaches that cancerous tissue is known to be aneuploid, that is, having an abnormal number of chromosomes. A slight amplification of a gene does not necessarily correlate with overexpression in cancer tissue, but can merely be an indication that the cancer tissue is aneuploid.” *Id.* In conjunction with Sen, the Examiner relies on Hittelman and argues Hittelman teaches that damaged, precancerous lung epithelium is often aneuploid. *Id.* Applicants respectfully disagree that the teachings of Sen and Hittelman are relevant because the amplification of PRO357 was confirmed by framework mapping, which was used to control for aneuploidy. See, e.g. paragraphs 0749 and 0731 of the present application. This ensures that the observed ΔCt value represents relevant gene amplification. Thus, the reported data are an indication of relevant gene amplification, and support the conclusion that PRO357 can be used as a cancer diagnostic. Appellants respectfully submit that neither Sen nor Hittelman demonstrates Appellants’ asserted utility is insufficient.

(2) None of Hanna, Godbout, Li, Pennica, or Konopka are Contrary to Appellants’ Asserted Utility

The Examiner alleges that even if the data were corrected for aneuploidy, the gene amplification data still does not support utility for the claimed polypeptides. Final Office Action mailed 8/18/08, at page 4. In support, the Examiner relies on references by Hanna, Pennica, Konopka Godbout, and Li.

(a) Hanna Supports Appellants’ Asserted Utility

According to the Examiner, Hanna provides “evidence that the level of polypeptide expression **must** be tested empirically to determine whether or not the polypeptide can be used as a diagnostic marker for a cancer.” Final Office Action mailed 8/18/08, at page 4 (see also Office Action mailed 1/12/06, at page 4). However, Hanna teaches that “*[i]f**[n]* *general,* FISH and IHC results correlate *well.*” Indeed, only for a “subset of tumors” were discordant results, such as protein overexpression without gene amplification or lack of protein overexpression with gene amplification, found. Thus, Hanna teaches that **generally** one of ordinary skill in the art would understand gene amplification levels to

correlate well with protein overexpression levels and supports Appellants' asserted utility.

**(b) Pennica and Konopka do not Overcome
Appellants' Evidence Supporting
Appellants' Asserted Utility**

Appellants respectfully disagree with the Examiner's continued reliance on Pennica and Konopka to reject the pending claims. Pennica does not demonstrate that more likely than not one of ordinary skill in the art would not expect gene amplification levels to correlate with protein overexpression. First, *WISP-1* gene amplification and RNA expression levels examined in Pennica showed a significant positive correlation. Second, although Pennica stated that *WISP-3* was not significantly amplified, it was amplified ($P=1.666$) and overexpressed. Third, although *WISP-2* gene amplification and RNA expression levels seemed to be inversely related, Pennica suggests that this result might be inaccurate: “[b]ecause the center of the 20q13 amplicon has not yet been identified, it is possible that the apparent amplification observed for *WISP-2* may be caused by another gene in this amplicon.” See Pennica at 14722. Thus, because the RNA expression pattern of *WISP-2* cannot be accurately attributed to gene amplification of *WISP-2*, this result should be disregarded. Indeed, the teachings of Godbout taken with Pennica suggest that Pennica’s conclusion that the observed amplification is not actually attributable to *WISP-2* is correct. Moreover, in the present case, appropriate controls for aneuploidy were used and page 137 of the present specification explains the procedures performed to confirm that the observed gene amplification was attributable in the present case to PRO357. Therefore, for this additional reason, Pennica *et al.* does not make it more likely than not that the present invention is not supported by a specific, substantial, and credible utility.

Appellants also disagree with the Examiner’s reliance on Konopka *et al.* to establish that “[p]rotein expression is not related to gene amplification but to variation in the level of mRNA produced from a single genomic template.” Appellants respectfully submit that the Examiner has generalized a very specific result disclosed by Konopka *et al.* to cover all genes. Konopka *et al.* actually state that “[p]rotein expression is not related to

amplification of the *abl* gene but to variation in the level of *bcr-abl* mRNA produced from a single Ph¹ template.” (See Konopka *et al.*, Abstract, emphasis added). The paper does not teach anything whatsoever about the correlation of protein expression and gene amplification in general, and provides no basis for the generalization that apparently underlies the present rejection. The statement of Konopka *et al.* that “[p]rotein expression is not related to amplification of the *abl* gene . . .” is not sufficient to establish lack of utility. It is not enough to show that for a particular gene a correlation does not exist. The law requires that the Examiner show evidence that it is more likely than not that such correlation, in general, does not exist. Such a showing has not been made.

Indeed, neither Pennica nor Konopka establishes that one of ordinary skill in the art would reject Appellants’ asserted utility. Both of these references were overcome during prosecution of the ’308 patent. Specifically, as explained above, the ’308 is assigned to, Genentech, Inc, who is the assignee of the present case. In the ’308 patent, the inventors asserted the same diagnostic utility for the claimed polypeptide that Appellants assert, specifically a diagnostic utility based on gene amplification resulting in overexpression of the mRNA and subsequently, the protein of the gene. The examiner of the ’308 patent repeatedly rejected but ultimately accepted that assertion of utility. In rejecting the assertion of utility, the examiner relied Pennica and Konopka but ultimately found these references overcome because the combined teachings of Pennica and Konopka are not directed towards the claimed polypeptide, nor towards genes in general, but rather are to a single gene or genes within a single family. Thus, their teachings cannot support a general conclusion regarding correlation between gene amplification and mRNA or protein levels. For these same reasons, Pennica and Konopka do not support the present rejection of the claims pending in this application and are overcome.

(c) Godbout and Li Do Not Establish One of Ordinary Skill in the Art Would More Likely than not Doubt Appellants’ Asserted Utility

The Examiner alleges Godbout teaches that “[t]he DEAD box gene, DDX1, is a putative RNA helicase that is co-amplified with MYCN in a subset of retinoblastoma (RB) and neuroblastoma (NB) tumours and cell lines. Although gene amplification usually

involves hundreds to thousands of kilobase pairs of DNA, a number of studies suggest that co-amplified genes are only overexpressed if they provide a selective advantage to the cells in which they are amplified.” Office action mailed 3/7/07, at page 8. Based on this statement in Godbout, the Office action argues that Appellants’ assertion of utility is not sufficient because the specification does not teach that the protein encoded by the PRO357 gene would confer any selective advantage on a cell expressing it.

Appellants respectfully disagree that Godbout teaches that amplified genes are *only* overexpressed if they provide a selective advantage. Rather, Godbout, which focuses on *co-amplified* genes, states that “it is unlikely that a gene located ~ 400 kb from the *MYCN* gene will be consistently amplified as an intact unit unless its product provides a growth advantage to the cell.” Page 21162 of Godbout. Thus, rather than conclude that an amplified gene must encode a polypeptide that provides a selective advantage, Godbout suggests that the selective advantage plays a role in why a particular gene may be co-amplified with another gene.

Appellants further respectfully submit that this aspect of the Godbout teachings is not relevant to Appellants’ assertion of utility, which is not based on any gene that is alleged to be co-amplified. Indeed, amplification of PRO357 was confirmed by epicenter mapping. Specifically, Appellants confirmed that amplification of the closest known epicenter markers did not occur to a greater extent than that of PRO357. Appellants teach that this “strongly suggests that the DNAs tested are responsible for the amplification of the particular region on the respective chromosome.” Paragraph 0750. Thus, based on this teaching of the specification, one of ordinary skill in the art would conclude that PRO357 is not a co-amplified gene but rather an amplified gene.

Further, Appellants note that regardless of the co-amplification aspect of the Godbout reference, this reference teaches that a DEAD box gene, DDX1, shows good correlation between gene copy number, DDX1 transcript levels, and DDX1 protein levels in all cancer cell lines studied. See pages 21164, 21167, and 21168. Thus, Godbout does not teach that Appellants’ assertion of utility is wholly inconsistent with or violates any

scientific principles nor does Godbout make it more likely than not that one of ordinary skill in the art would doubt Appellants' assertion of utility.³

Li teaches that "genes that are concurrently amplified because of their location with respect to amplicons" generally do not show correlation between gene amplification and mRNA or polypeptide overexpression. However, just as Godbout is not persuasive evidence, Applicants respectfully disagree that Li is persuasive evidence in the context of the present invention. Framework and epicenter mapping analyses were carried out for PRO357 to confirm that PRO357, and not some other gene, is responsible for the observed gene amplification. This coupled with the high rates of observed amplification (approximately 2 to 8 fold amplification in nearly 93% of all lung tissues tested and 75% of all colon tissues tested) indicates that PRO357 gene amplification more likely than not correlates with overexpression of the PRO357 polypeptide.

Indeed, Appellants respectfully disagree with the Examiner's position that Li is relevant for teaching that "68.8% of the genes showing overrepresentation in the genome did not show elevated transcript levels." (Page 7 of the Office Action mailed 1/22/08; Page 9 of the Final Office Action mailed 8/18/08). Appellants respectfully pointed out that Li acknowledged that their results differed from those obtained by Hyman and Pollack (both of record), who found a substantially higher level of correlation between gene amplification and increased gene expression. Specifically, Li notes that "[t]his discordance may reflect that methodologic differences between studies or biological differences between breast cancer and lung adenocarcinoma." (Page 2629, col. 1). For instance, as explained in the Supplemental Information accompanying the Li article, genes were considered to be amplified if they had a copy number ratio of at least 1.40.

³ For the same reasons, Appellants respectfully disagree with the Examiner's position at pages 6-7 of the Final Office Action mailed 8/18/08 that Saretzki, Sohn, Forus, Walch, de la Guardia, Walker, Blancato and Cancer Medicine (made of record in Appellants' Request for Reconsideration filed 5/12/08) may be *discounted* because the molecules discussed in those references have been shown, or are suggested to provide a selective advantage.

The Examiner alleges that some samples were required to bind with 2-fold amplification and based on this, alleges Li demonstrates one of ordinary skill in the art would not accept Appellants arguments that the 2 to 8 fold amplification demonstrated for the PRO357 nucleic acid would correlate with PRO357 polypeptide levels. Appellants respectfully disagree. In particular the Second Polakis Declaration demonstrates that greater than 80% of the amplified genes identified in the Tumor Antigen Project (through which PRO357 was identified), demonstrate correlation between gene amplification and mRNA and polypeptide overexpression. *Supra* at 23-24. In view of the evidence of record, the results of Li do not conclusively disprove that a gene such as PRO357, which has a substantially higher level of gene amplification than the genes examined by Li, would be expected to show a corresponding increase in transcript expression.

For the reasons discussed above, Appellants respectfully maintain that the *totality* of this evidence currently under consideration demonstrates that it is more likely than not that one of ordinary skill in the art would accept Appellants' assertion of utility based on the principle that PRO357 is more likely than not overexpressed in lung or colon tumor tissues.

4. The Claimed Invention is Supported by a Utility that is Specific, Substantial, and Credible

Finally, use of the polypeptide sequence of PRO357 as a diagnostic marker is a specific, substantial, credible, and well established utility.

"Specific utility" is defined as:

[a] utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention. For example, a polynucleotide whose use is disclosed simply as a 'gene probe' or 'chromosome marker' would not be considered to be *specific* in the absence of a disclosure of a specific DNA target. Similarly, a general statement of diagnostic utility, such as diagnosing an unspecified disease, would ordinarily be insufficient absent a disclosure of what condition can be diagnosed.

Revised Interim Utility Guidelines Training Materials, pgs. 5-6 (<http://www.uspto.gov/web/offices/pac/utility/utilityguide.pdf>). At pages 119 and 137 of the specification, the

presently claimed polypeptides are asserted to be useful as targets for therapeutic intervention in lung or colon cancer or as diagnostic markers, indicating the presence of tumor cells in lung or colon tissue samples. These utilities are specific to the claimed polypeptides, which are encoded by nucleic acids that are amplified in lung or colon tumors.

“Substantial utility” is defined as:

a utility that defines a ‘real world’ use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a “real world” context of use are not substantial utilities. For example, both a therapeutic method of treating a known or newly discovered disease and an assay method for identifying compounds that themselves have a “substantial utility” define a “real world” context of use. An assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular disease condition would also define a “real world” context of use in identifying potential candidates for preventive measure or further monitoring.

Revised Interim Utility Guidelines Training Materials, pg. 6 (<http://www.uspto.gov/web/offices/pac/utility/utilityguide.pdf>). The presently claimed polypeptides are also supported by a substantial utility because the utilities discussed above, *i.e.* therapeutic targets and diagnostic markers, are real world uses. For example, similar to the statement found in the above quote from the Guidelines, the present specification discloses an assay that measures gene amplification in cancerous cells. The patents, declarations and articles discussed above, *supra* at 9-31, correlate that gene amplification in cancerous cells with polypeptide overexpression in cancerous cells. Therefore, the claimed polypeptides are supported by a substantial utility.

“Credible” utility is defined as:

Where an applicant has specifically asserted that an invention has a particular utility, that assertion cannot simply be dismissed by Office personnel as being ‘wrong’. Rather, Office personnel must determine if the assertion of utility is credible (*i.e.*, whether the assertion of utility is believable to a person of ordinary skill in the art based on the totality of evidence and reasoning provided). An assertion is credible unless (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based are inconsistent with the logic underlying the assertion. Credibility as used in this context refers to the reliability of the statement based on the logic and

facts that are offered by the applicant to support the assertion of utility. A *credible* utility is assessed from the standpoint of whether a person of ordinary skill in the art would accept that the recited or disclosed invention is currently available for such use. For example, no perpetual motion machines would be considered to be currently available. However, nucleic acids could be used as probes, chromosome markers, or forensic or diagnostic markers. Therefore the credibility of such an assertion would not be questioned, although such a use might fail the *specific* and *substantial* tests.

Revised Interim Utility Guidelines Training Materials, pg. 5 (<http://www.uspto.gov/web/offices/pac/utility/utilityguide.pdf>). The present invention is supported by a credible utility. As discussed above, *supra* at 9-31, the patents, declarations, and references cited by Appellants demonstrate that the logic underlying Appellants assertion of utility is not seriously flawed, nor are the facts upon which utility is asserted inconsistent with the logic underlying the assertion of utility. Therefore, utilizing the claimed polypeptides as therapeutic targets or diagnostic markers in lung or colon cancer is a credible utility.

A “well established” utility is a:

specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification’s disclosure of the properties of the material, alone or taken with the knowledge of one skilled in the art.

Revised Interim Utility Guidelines Training Materials, pg. 7 (<http://www.uspto.gov/web/offices/pac/utility/utilityguide.pdf>). For the reasons demonstrated above, *supra* at 9-31, Appellants’ asserted utility is specific, substantial, and credible. Hence, it is also well known.

For all the above reasons, Appellants have demonstrated currently pending claims 27-29 and 32-34 are supported by an asserted specific, substantial, credible and well-established utility and therefore, respectfully request that the rejection of claims 27-29 and 32-24 for lack of utility be reversed.

C. The Enablement Rejection Under 35 U.S.C. § 112, First Paragraph Should Be Withdrawn

In the Final Office Action mailed August 18, 2008, the Examiner maintains the rejection of claims 27-29 and 32-34 under 35 U.S.C. § 112, first paragraph, because it is alleged

that the presently claimed invention is not supported by a substantial utility, and therefore, one skilled in the art would not know how to use the claimed invention. As discussed in the remarks above, Appellants respectfully submit that the claimed polypeptide is supported by a substantial utility. Accordingly, Appellants respectfully request reconsideration and reversal of the rejection of claims 27-29 and 32-34 under 35 U.S.C. § 112, first paragraph as allegedly not enabled because one of ordinary skill in the art allegedly would not know how to use the claimed PRO357 polypeptides.

D. The Anticipation Rejection Under 35 U.S.C. § 102 Should Be Withdrawn

The Examiner also maintains the rejection of claims 27-29 and 32-34 under 35 U.S.C. § 102 as allegedly being anticipated by Botstein (WO 99/35170) in the Final Office Action mailed August 18, 2008. Specifically, the Office action asserts that Appellants cannot rely on the filing date of U.S. Provisional Application Serial No. 60/113,269, filed December 22, 1998 under 35 U.S.C. § 120 because that application allegedly does not set forth any utility for the claims under 35 U.S.C. §§ 101 and 112. Office action mailed 8/18/08.

Appellants respectfully disagree with this ground of rejection. Appellants rely on the filing date of US Provisional Application Serial No. 60/113,296, which is prior to the publication date of the cited reference. For the reasons discussed above, the gene amplification experiment discussed in both the present application and provisional application 60/113,296 satisfies the requirements of 35 U.S.C. §§ 101 and 112. As such, Applicants respectfully submit that rejection of claims 27-29 and 32-34 under 35 U.S.C. § 102(b) based on the Botstein reference (WO 99/3517, published 7/15/99) is improper and respectfully request that this rejection be reversed.

VIII. CONCLUSION

For the reasons given above, Appellants submit that the specification discloses at least one patentable utility for the PRO357 polypeptides of claims 27-29 and 32-34, and that one of ordinary skill in the art would understand how to used the claimed polypeptides, for example in the diagnosis of lung and colon tumors. Therefore, claims 27-29 and 32-34 meet the requirements of 35 USC §§101, 102, and 112, first paragraph.

Accordingly, reversal of all the rejections of claims 27-29 and 32-34 is respectfully requested.

Respectfully submitted,

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CLAIMS APPENDIXLISTING OF THE CLAIMS:

Claims 1-26 (canceled)

Claim 27 (previously presented): An isolated polypeptide comprising:

- (a) the amino acid sequence of the polypeptide shown in Figure 26 (SEQ ID NO:69);
- (b) the amino acid sequence of the polypeptide shown in Figure 26 (SEQ ID NO:69), lacking its associated signal peptide; or
- (c) the amino acid sequence of the polypeptide encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 209527.

Claim 28 (previously presented): The isolated polypeptide of Claim 27 comprising the amino acid sequence of the polypeptide shown in Figure 26 (SEQ ID NO:69).

Claim 29 (previously presented): The isolated polypeptide of Claim 27 comprising the amino acid sequence of the polypeptide shown in Figure 26 (SEQ ID NO:69), lacking its associated signal peptide.

Claim 30-31 (cancelled)

Claim 32 (previously presented): The isolated polypeptide of Claim 27 comprising the amino acid sequence of the polypeptide encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 209527.

Claim 33 (previously presented): A chimeric polypeptide comprising a polypeptide according to Claim 27 fused to a heterologous polypeptide.

Claim 34 (previously presented): The chimeric polypeptide of Claim 33, wherein said heterologous polypeptide is an epitope tag or an Fc region of an immunoglobulin.

Claims 35 -36 (canceled)